

REMARKS

This Amendment is responsive to the Office Action dated December 1, 2005. Applicant has amended claims 55, 68, 69, 74 and 83. Claims 1-156 and 158-170 remain pending, with claims 1-54 and 88-155 being withdrawn in response to a Restriction Requirement

Inadequacy of Examination

In the previous, non-final Office Action, the Examiner rejected all of Applicant's claims as being anticipated by U.S. Patent App. Pub. No. 2002/0022970 by Noll (Noll). In Applicant's previous Response, Applicant commented at length regarding the inadequacy of the examination apparent in the previous Office Action. Applicant particularly noted the conclusory nature of the claim rejections, the obvious lack of relevance of Noll to the claims, and the Examiner's apparent failure to consider each and every limitation of each of the forty-eight pending claims, as he was obligated to do.

Unfortunately, the current, second, non-final Office Action exhibits most of the same inadequacies. For example, the Examiner has rejected each of forty-eight claims, reciting numerous different limitations, based on the repeated, conclusory citation of four unrelated paragraphs from a seventy-two page reference. The reference as a whole, and particularly the cited paragraphs, appears to be irrelevant to the majority of the requirements of Applicant's claims.

Moreover, it is again apparent that the Examiner failed to consider each and every limitation of each of the forty-eight pending claims, as he was obligated to do. For example, with regard to claims 74-87 and 156-170, the Examiner merely stated that "they disclosed the same limitation as claims 55-73 and are taught by the cited reference...[t]herefore they are rejected under the same rationale." **This statement is clearly incorrect.**

For example, independent claim 74 requires "monitoring compliance of the online entity to the commitment, and updating the media object based upon the monitoring step." These limitations are not recited in any of claims 55-73.

As another example, claim 77 recites "wherein the monitoring step comprises monitoring feedback from users of the electronic commerce or from online sales activities." This limitation is not recited in any of claims 55-73.

As other examples, claim 78 recites “wherein the monitoring step is accomplished periodically,” and claim 79 recites “wherein the monitoring step is accomplished at least daily.” These limitations are not recited in any of claims 55-73.

Claim 80 recites, “wherein the media object is also representative of a seal of certification.” This limitation is not recited in any of claims 55-73.

Independent claim 83 recites “a datastore to store data reflecting the commitment by an online entity, and a server to control the display of a media object representative of the commitment and to automatically control whether the media object is communicated to a device for presentment to the potential buyer based on whether the stored data of the datastore indicates compliance with the selling practice by the entity.” These limitations are not recited in any of claims 55-73.

Claims 156 and 158 recite “further comprising displaying the media object as a portion of results from the search engine.” This limitation is not recited in any of claims 55-73.

Similarly, claim 163 recites “wherein the server controls the display of the media object as a portion of the results from the search engine. This limitation is not recited in any of claims 55-73.

As other examples, claim 164 recites “wherein monitoring compliance comprises monitoring historical or current marketplace data,” claim 165 recites “wherein the marketplace data comprises a reputation rating of the online entity,” and claim 166 recites “wherein the marketplace data comprises sales characteristics of the online entity.” These limitations are not recited by any of claims 55-73.

For a second time, the Examiner is reminded that the Administrative Procedure Act requires that a rejection under 35 U.S.C. § 102(e) be the result of “reasoned decision making,” i.e., be supported by a substantial evidentiary record and well-articulated rationale.¹ The Code of Federal Regulations and Manual of Patent Examining Procedure reflect this requirement, stating that the pertinence of each reference must be clearly explained, and that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the Applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest

¹ See *In re Lee*, 61 USPQ2d 1430, 1432-35 (CAFC 2002).

opportunity.² In other words, to support the rejection of Applicant's claims under section 102(e), the Examiner was obligated consider each and every limitation of each of the claims, and provide clear explanation of what teachings in the cited reference the Examiner believed anticipated each limitation. In the second, non-final Office Action, the Examiner **once again did not fulfill this obligation**.

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 55-87 and 156-170 under 35 U.S.C. § 102(e) as being anticipated by US Patent App. Pub. No. 2005/0044009 by Stone et al. (Stone). Applicant respectfully traverses these rejections, particularly to the extent they are considered applicable to the claims as amended. Stone fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. § 102(e), and provides no teaching that would have suggested the desirability of modification to include such features.

For example, Stone fails to provide any teaching or suggestion of communicating a commitment to a selling practice made by an online entity to a potential buyer, as required by each of Applicant's independent claims 55, 74 and 83. Applicant has amended each of the independent claims to clarify that the commitment is made by the online entity and, for example, accepted, prior to any interaction between the online entity and the potential buyer in a marketplace or commerce. Stone provides no teaching or suggestion of communicating such a pre-commitment to a potential buyer.

Instead, Stone teaches a system that facilitates distribution of advertisements of goods or services by sellers, referred to as presentations, via a variety of media. The Stone system also facilitates receipt of offers from buyers to purchase or reserve the goods or services, and acceptance of the offers by the sellers, via computer networks. Neither the presentations, nor the acceptance of an offer from the buyer by a seller described by Stone, are a commitment made by an online entity to a selling practice prior to any interaction between the online entity and the **potential** buyer in a marketplace or commerce, and communicated to the potential buyer.

In particular, an advertisement presented to a buyer in the Stone system is not representative of any commitment on the part of the seller, much less a commitment to a selling

² 37 C.F.R. § 1.104(c)(2) and M.P.E.P. § 706.

practice, as required in each of Applicants' independent claims. Further, acceptance of an offer from a buyer by a seller in the Stone system necessarily occurs at the culmination of the interaction between the buyer and the seller. Accordingly, this type of seller acceptance does not even suggest a commitment made by an online entity to a selling practice prior to any interaction between the online entity and the potential buyer, as required by each of Applicant's independent claims.

The Examiner cites paragraphs [0137], [0309], [0310] and [0343] of Stone as teaching all of the requirements of the independent claims, as well as every requirement of Applicant's forty-five pending dependent claims. However, the teachings within these paragraphs are irrelevant to the substantial majority of the requirements of Applicant's claims.

For example, paragraph [0137] provides that a definition for the term "reservation" is a "promise or commitment made by the Buyer and held by the Seller, to take, use, consume, utilize, attend, or enjoy a unit of inventory."³ This paragraph is simply not relevant to Applicant's claims, which are directed to a commitment made by an online entity, e.g., a seller, and communicated to a potential buyer.

Further, although paragraphs [0309] and [0310] refer briefly to a "commitment" made by a seller to deliver a good or service to a buyer who has offered to purchase or reserve the good or service, this type of seller commitment does not even suggest the requirements of Applicant's independent claims. As discussed above, acceptance of an offer by a Seller necessarily occurs at the culmination of the interaction between the buyer and the seller, directly contrary to the requirement of Applicant's independent claims of a commitment made by an online entity to a selling practice prior to any interaction between the online entity and the potential buyer. Discussion at other locations within Stone, such as at paragraphs [0245] and [0252], confirms that the type of seller commitment described in paragraphs [0309] and [0310] does not occur prior to any interaction between an online entity and a potential buyer, as required by the amended independent claims.

Paragraph [0343] also fails to teach or suggest communicating a commitment to a selling practice made by an online entity prior to any interaction between the entity and a potential buyer to the potential buyer, as required by the amended independent claims. Instead, paragraph [0343]

³ Emphasis added.

generally discusses sellers using the Stone system to provide advertisements to various media. As discussed above, an advertisement presented to a buyer in the Stone system is not representative of any commitment on the part of the seller, much less a commitment to a selling practice, as required in each of Applicants' independent claims.

To the extent the Examiner's position is that an advertisement itself represents some form of a commitment to a selling practice, **Stone simply provides no teaching or suggestion of monitoring or otherwise determining whether an online entity is complying with a commitment to a selling practice and taking some affirmative action in response, as required by each of the independent claims**. For example, Stone fails to disclose or suggest monitoring compliance of the online entity with a commitment to a selling practice, automatically restricting display of the online entity as a result of a search engine when the entity fails to comply with the commitment, and delivering a media object to a device for presentment to the potential buyer, the media object representative of the commitment, when the entity complies with the commitment, as required by amended independent claim 55. Stone similarly fails to disclose or suggest monitoring compliance of the online entity to the commitment, and updating the media object based on the monitoring step," as required by independent claim 74, and "a server configured to...automatically control whether the media object is communicated to a device for presentment to the potential buyer based on whether the stored data of the datastore indicates the commitment and compliance with the selling practice by the entity," as required by amended independent claim 83.

The teachings within Stone relating restriction of display and modification of seller presentations, i.e., advertisements, such as the discussion at paragraph [0343] which was cited by the Examiner, are irrelevant to the above-identified requirements of the independent claims. In contrast to these requirements of Applicant's claims, Stone teaches that such presentations may be restricted by a media venue for editorial reasons related to the desire of the media venue *to control the look and content of presentations*.⁴ For example, Stone teaches that media may restrict presentations to particular amounts of text and size of images, language and reference, standards of style and presentation, choices of type fonts and colors, or the like.⁵ Such

⁴ Stone, paragraphs [0084], [0175] and [0334].

⁵ Stone, paragraph [0334].

restrictions are clearly not based on whether an online entity is *complying with a selling practice* and, therefore, clearly fail to even suggest the requirements of Applicant's independent claims.

Additionally, with respect to the requirements of independent claims 55, Stone does not teach or suggest any restriction of display of an online entity, for any reason. In fact, Stone identifies providing maximum visibility for sellers on search engines as one of the objects and advantages of the invention described therein.⁶

Stone also fails to disclose or suggest a majority of the requirements of Applicants' dependent claims.

For example, Stone fails to provide any disclosure relevant to a buyer guarantee, as recited in each of claims 57-61, 76, 85, 160-162 and 168-170.

Stone also fails to disclose or suggest an electronic seal, as recited by claim 65, or a seal of certification, as recited by claim 80.

Stone also provides no teaching relating to monitoring feedback from users of electronic commerce or from online sales activities, as recited by claim 77, or a reputation rating of an online entity, as recited in claim 165.

Stone also fails to provide any teaching relating to an online dispute resolution system, as recited in claim 155.

The preceding examples were not a complete or exhaustive list of the shortcomings of Stone with respect to the dependent claims.

In sum, Stone fails to disclose each and every limitation set forth in claims 55-87 and 156-170, including a number of limitations of each of amended independent claims 55, 74 and 83. For at least this reason, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 55-87 and 156-170 under 35 U.S.C. § 102(e). Withdrawal of these rejections is requested.

⁶ Stone, paragraph [0024].

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CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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By:

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